

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

The Office Action makes no reference to the drawings. Applicant therefore respectfully requests that an indication be given that the drawings have been accepted.

After amending the claims as set forth above, claims 1, 3 and 20 are now pending in this application.

Objection to the Disclosure

At page 2, the Office Action objected to the disclosure for failing to make reference to the parent application. Please note that this was done in the preliminary amendment of February 2, 2004. This information has been updated.

Rejection of claims 1 and 3 under 35 U.S.C. §112

At page 2, the Office Action rejects claims 1 and 3 under 35 U.S.C. §112, second paragraph, as being indefinite. Applicant has provided a clarifying amendment to claim 1 and thus respectfully requests withdrawal of the rejection.

Rejection of claims 1, 3 and 20 under 35 U.S.C. §103(a) over Volle in view of Azumano and in further view of Akimoto

The Office Action rejected claims 1 and 3 under 35 U.S.C. §103(a) over Volle in view of Azumano in further view of Akimoto. The Office Action further rejected claim 20 under 35 U.S.C. §103(a) over Volle in view of Azumano. The rejection is believed to be improper and reconsideration is respectfully requested.

To establish a *prima facie* case of obviousness, the prior art when combined must both teach or suggest all the claim limitations and provide some “suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings....The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure.” MPEP §2143.

In the present case, neither of these prerequisites have been fulfilled. First, the cited references, even if combined, do not teach all elements of the claims 1 and 20. As acknowledged in the Office Action at page 3, Volle does not describe workstations and changers which are open to one another, and does not describe the axial movement of a changer. At pages 3-4, the Office Action states that

Volle’s teaching (col. 4, lines 58-64) that wafers are simultaneously tested in various workstations and are consecutively moved from one workstation into another without having to be exposed to the outer atmosphere of the device suggests that at least one work station and the changer are open to each other.

The Applicant respectfully disagrees with this conclusion, as there is nothing in Volle that would prevent a workstation from being closed to other workstations and the changer while still being capable of providing consecutive movement. Nevertheless, the observation is respectfully deemed to be moot in light of the Applicant’s clarifying amendment to claim 1 and the language already found in claim 20.

The Office Action further states at page 3:

In the alternative, it would have been obvious to have two of the stations and changer open to each other when moving a substrate from one workstation into another workstation so that a wafer under test may be quickly moved from one workstation to the other in the consecutive (“consecutively”, line 62, col. 4 of Volle) manner called for by Volle.

This observation is also respectfully believed to be moot in light of the clarifying amendment to claim 1. To the extent that it is not moot, the Office Action appears to be

employing impermissible hindsight. Specifically, there is no indication of the source for the suggestion to modify Volle, other than the process employed by Volle himself. The suggestion that the process and apparatus of Volle render improved versions of the process and apparatus obvious to a person of ordinary skill in the art is undermined by the fact that Volle himself did not see fit to use these desirable variants, nor even to mention the possibilities speculatively in his patent application. The fact that Volle's processing steps are carried out "consecutively" can be of no consequence, since all industrial processes are carried out to some extent consecutively. Instead, one must look to the actual process steps being carried out for their teachings. Here, Volle is employing individual processes requiring vacuum and being performed in reactors, which suggests to a person of ordinary skill in the art that his "process chambers" could not be opened to one another. See Volle, col. 4, lines 24-25.

Nor are the missing claim elements to be found in Azumano. In particular, Azumano does not teach, disclose or suggest the use of workstations open to one another. The cited portions of Azumano (in particular Figure 5) refer only to open "transfer tables" (5a and 5b), which are not workstations, as no work is being done. *See* Azumano, col. 3, lines 51-56. Azumano further does not suggest the particular motion required by claims 1 and 20.

Akimoto may also not be used to modify Volle. While it does appear that Akimoto teaches stacked wafers, the particular motion required by the claims is not taught. *See* MPEP §2143.03. To employ a metaphor, the combination of vertical motion in Akimoto and rotational motion in Volle does not necessitate the particular sequence of motions described by the claims any more than a general description of how to turn left or right would lead one to work in the morning. This is best evidenced by the fact that Volle himself employs stacked wafers as in Akimoto, but does not employ the motion of claim 1. Instead, Volle teaches allowing the *wafer magazine* (not the changer) to move vertically. *See* Volle, col. 4, lines 29-30.

The Applicant thus respectfully requests that the rejections be withdrawn.

Rejection of claim 20 under 35 U.S.C. §103(a) over Hunter in view of Volle

At pages 4-5, the Office Action rejects claim 20 under 35 U.S.C. §103(a) over Hunter in view of Volle. The rejection is believed to be improper and reconsideration is respectfully requested.

Specifically, the rejection does not appear to have established, in a manner sufficient for a *prima facie* case of obviousness, that the combination of Hunter with Volle discloses “a changer arranged in the same housing and at least three workstations being open to each other” as recited in claim 20. *See* MPEP §2143.03. Volle does not disclose this claim element at least for the reasons stated above. Hunter also does not appear to disclose or suggest the claim element, as the cluster tool 100 shown in Figure 5 comprises a “plurality of chambers”. *See* Hunter, col. 9, lines 57-58. The workstations of Hunter are thus not “open to each other” in the sense of claim 20. Since none of the other references appear to disclose this limitation, a *prima facie* case of obviousness has not been established.

Applicant thus respectfully requests that the rejection be withdrawn.

Provisional Double Patenting Rejection

The Office Action provisionally rejected claims 1, 3 and 20 over co-pending application 10/379,677 under the doctrine of obviousness-type double-patenting. The Applicant submits herewith an appropriate terminal disclaimer and thus respectfully requests withdrawal of the rejection.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to

Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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